

R E M A R K S

Claims 1-4, 6-11, 14-15, 25-31 are pending in the above-referenced application. Claims 7 and 16 have been canceled. Claims 6, 14, 15, 25, 26, 29 and 31 have been amended to more distinctly claim that which Applicant regards as the invention. Specifically claim 6 has been amended to recite that human adipocyte enhancer binding protein 1 is expressed; claims 14 and 15 have been amended to recite that the kit comprises one or more nucleic acid molecules of claim 8; claim 25 has been amended to recite that the presence or absence of a variant in said genomic DNA is determined using a nucleic acid molecule comprising at least 20 contiguous nucleotides of an intron region of SEQ ID NO:8; claim 26 has been amended to recite that the nucleic acid molecule comprises at least 20 nucleotides of the intron region of SEQ ID NO:8 or its complementary sequence; claim 29 has been amended to recite that the claimed method comprises: (a) contacting the sample with a nucleic acid molecule comprising at least 20 contiguous nucleotides of SEQ ID NO:8 or its complementary sequence under stringent hybridization conditions and (b) determining whether the nucleic acid molecule in (a) binds to a polynucleotide in the sample, wherein binding of a polynucleotide of the sample to the nucleic acid molecule of (a) detects the presence of a polynucleotide comprising SEQ ID NO:8 or its complementary sequence. Claim 31 has been amended to recite that the fragment comprises at least 20 contiguous nucleotides of the intron region comprising the sequence of nucleotides between positions 9015-10,641 or its complementary sequence. New claim 32 has been added to recite that the nucleic acid molecule is a fragment of intron regions 8122-8672, 6662-7475, 5456-6218, 4834-5211, and 4053-4319.

Applicant would like to thank Examiner J. Zara for her time and most helpful suggestions during her interview with Applicant's representative, Cheryl H. Agris on June 19, 2008. The substance of the interview is provided below.

I. Substance of Interview

A. Brief Description of the Nature of an Exhibit Shown or Any Demonstration Conducted

No exhibit was shown and no demonstration was conducted.

B. Identification of the Claims Discussed

Claims 1-4, 6-11, 14-16, 25-29 and proposed claims 30-31 were discussed.

C. Identification of Specific Prior Art Discussed

No prior art was discussed.

D. Identification of the principal proposed amendments of a substantive nature discussed

The cancellation of claim 16 and proposed amendment of claim 31 was discussed. Furthermore, the addition of extra claims reciting intron regions was discussed.

E. The General Thrust of the Principal Arguments of the Applicant and Examiner

Most of the discussion centered on rejoinder of claims 25-29 and claims 30-31 to the allowed claims. Applicant asserted that claims 25-29 are related to claim 1 as method of using a product recited in claim 1, e.g., SEQ ID NO:8 and thus subject to rejoinder in view of MPEP 821.04(b). Applicant asserted that the restriction of claims 8 and 30 should be withdrawn because in Applicant's view, the original restriction made was a species restriction. Claim 31 has been amended to recite the elected species. The Examiner stated that she would consider the arguments made.

F. General Indication of Any other Pertinent Matters Discussed

The rejection under 35 USC 112, second paragraph was also discussed.

G. General Results/Outcome of Interview

Claim 16 is canceled. The Examiner will consider rejoining claims 25-29 and will consider arguments about the scope of claims, 8 and 30 and claims directed to any other intron fragments.

II. The Restriction Requirement

It was noted in the Office Action that claims 7, 25-29, and SEQ ID Nos. other than SEQ

ID NO. 8 and other than the intron subsequence comprising nucleotides 9015-10,641 of SEQ ID NO. 8, are withdrawn from examination, as being drawn to non-elected inventions. In response, Applicant first notes that claim 7 has been canceled without prejudice. Applicant reserves the right to file subsequent continuation and/or divisional applications on canceled subject matter.

Further, as noted above, Applicant asserts that claims 25-29 should be rejoined to the allowed claims, 1-4, 6 and 10 in view of MPEP 821.04(b). Applicant notes that MPEP 821.04(b) states

...if applicant elects a claim(s) directed to a product, which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder.

In the present case claims 25, 27-29 contains all of the limitations of allowable claim 1; claim 26 depends from claim 1. Therefore claims 25-29 meet the criteria of MPEP 821.04(b).

Applicant asserts that it should not be necessary to limit claim 8 to just one intron sequence. In the Office Action dated October 26, 2007, it was stated

The other introns within SEQ ID NO. 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

In Applicant's view, the election of the intron region between positions 9015-10,641 constitutes merely a species election. Given that the linking claim, claim 1, is deemed to be allowable, the Restriction Requirement with respect to claim 8 should be withdrawn.

III. Claim Rejections - 35 USC § 112

Claim 16 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action specifically states:

Claim 16 depends from claim 14, which claims a single nucleic acid molecule. Claim 16, however, encompasses a kit comprising the single nucleic acid molecule of claim 14, as well as a plurality of nucleic acid molecules. It is unclear, however, what is encompassed by this "plurality of nucleic acid molecules." The metes and bounds of the claimed invention cannot be determined. Appropriate clarification is required.

Applicants respectfully traverse the rejection. However, in order to advance prosecution, claim 16 has been canceled without prejudice. However, claim 14 has been amended to be directed to one or more nucleic acid molecules of claim 8.

IV. Conclusion

In view of the foregoing, Applicants assert that the claims are now in condition for allowance. Early action to that end is respectfully requested. The Examiner is invited to contact the undersigned at (914) 712-0093 if he has any questions.

Respectfully submitted,

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